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PATENT

Attorney Docket No.: 29089/34670A

Cur 1636

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mohr et al.)	I hereby certify that this paper is being
)	deposited with the United States Postal
Serial No.: 09/619,144)	Service on November 1, 2001 , in an
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Filed: July 19, 2000)	Commissioner for Patents,
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For: Culturing Device and Method)	"Express Mail Post Office to
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Group Art Unit: 1636)	
)	
Examiner: Dr. W. Sandals)	
)	Richard Zimmermann
)	
)	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper is in response to the official action dated October 1, 2001 setting forth a restriction requirement. A provisional election is made herein, *with traverse*, as set forth below. Reconsideration and withdrawal of the restriction requirement is respectfully requested.

Traverse of the Restriction Requirement

The official action sets forth a restriction requirement between the claims of Group I (claims 1-27, stated as "drawn to a culturing device") and Group II (claims 28-31, stated as "drawn to method of culturing") as distinct from one another. The reasoning or explanation provided in support of the requirement is that the claims of

Groups I and II are “related as process and apparatus for its practice.” The action states that the “inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus, or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.”

In support of the requirement, the official action cites MPEP §806.05 (e) and states only that in “this case the process claimed can be performed by another apparatus such as a hollow fiber device.” The applicants request reconsideration and withdrawal of the restriction requirement as improper based on the several grounds set forth below.

I. The Standard for Requiring Restriction Has Not Been Met

The restriction requirement is improper on its face because it does not meet the minimum required standard set forth in MPEP §803. Section 803 requires two criteria for a proper requirement of restriction for purported patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, regardless of whether the inventions are independent or distinct, there “must be a serious burden on the examiner if restriction is required” (emphasis added). Referring to the second requirement, §803 recites that “if the search or examination of an entire application can be made *without serious burden*, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions” (emphasis added). There is no evidence in the record that search and examination of the entire application would be *any* burden, much less a *serious* burden, on the examiner, as is necessary for upholding a proper restriction requirement.

To further support the applicant's position, a complete search for the claims of either elected Group I or Group II would require a search directed to subject matter of the claims from the other non-elected claim group. Since the search and examination of the entire application can be made *without serious burden* on the examiner, it is wasteful of time, effort, and resources for both the applicants and the Patent Office to prosecute the claims in separate applications. Search and examination of all claims together in this application would be much more efficient than requiring both the Patent Office and the applicants to do so separately in multiple applications.

The applicants therefore *traverse* the restriction requirement on the grounds that the minimum standard for requiring a proper restriction set forth in MPEP §803 has not been met. The restriction requirement should be withdrawn and all claims 1-31 searched and examined in the present application. Such action is hereby respectfully solicited.

II. The Restriction Requirement is Improper for Failure to Set Forth a Proper Showing

The restriction requirement is also improper on its face because the official action has failed to put forth the proper showing, as required in MPEP §808.02. The official action allegedly establishes that the inventions in Groups I and II are related as process and apparatus for its practice as defined under MPEP §806.05(e). If this is the case, then §808.02 requires that, "in order to establish reasons for insisting upon restriction, [the examiner] must show *by appropriate explanation*" (emphasis added) that each of the claim groups requires either (A) a separate classification, (B) a separate status in the art when they are classifiable together, or (C) a different field of search. Here, the official action indicates that the claim groups require separate

classification and lists same. However, §808.02 states in addition that appropriate explanation must also be set forth. No such explanation is provided in the official action.

The applicants therefore traverse the restriction requirement on the additional grounds that the official action has failed to set forth or establish reasons by appropriate explanation for insisting upon the restriction, as required under MPEP §808.02. The restriction requirement should be withdrawn and all claims 1-31 searched and examined in the present application. Such action is hereby respectfully solicited.

III. Effect of Improperly Upholding the New Restriction Requirement

The effect of the Patent Office upholding the improper restriction requirement is that the Patent Office admits that the claims of Groups I and II are patentable over the disclosure of any other of the these groups. MPEP §802.01 states that distinctness for a restriction requirement means that two or more subjects as claimed “ARE PATENTABLE (novel and unobvious) OVER EACH OTHER” (emphasis in original). The effect of upholding the restriction requirement is that the Patent Office *admits* that the claims of Groups I and II are patentable over any disclosure of the claims in any of the other groups.

This position is necessary to entry of the restriction requirement by the Patent Office. Thus, if the restriction requirement is upheld, the applicants can and will rely upon this position during examination of this application and any continuing applications. If this position is not to be taken by the Patent Office, then the applicants request that the restriction requirement be withdrawn.

IV. Provisional Election

The restriction requirement is set forth between the claims of Group I (claims 1-27, stated as "drawn to a culturing device") and Group II (claims 28-31, stated as "drawn to method of culturing"). The applicants *provisionally elect*, as required for a complete response, **claims 1-27 of Group I drawn to a culturing device**. However, the applicants make this provisional election *with traverse* in accordance with the foregoing remarks.

CONCLUSION

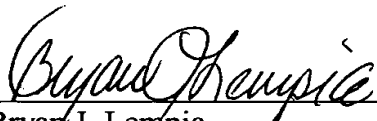
Reconsideration and withdrawal of the restriction requirement is solicited for the foregoing reasons. As a result, consideration and examination of all claims 1-31 pending in the application is further solicited.

Should the examiner wish to discuss the foregoing or any matter of form in an effort to advance this application toward allowance, the examiner is invited to telephone the undersigned at the below-listed number.

Respectfully submitted,

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